

Remarks/Argument

Obviousness Type Double Patenting

Claims 16-28 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12-20 of copending Application No. 10/269,903. Applicants submit herewith a Terminal Disclaimer. Applicants respectfully request withdrawal of the Examiner's provisional rejection.

Rejection under 35 USC §103(a)

Claims 12-16 and 18-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Howe et al. (5,458,785) in view of Benner and/or Tepic. Claim 17 was rejected under 35 U.S.C. §103(a) as being unpatentable over Howe et al. (5,458,785) in view of Benner and/or Tepic in further view of Beinhaus. Applicants respectfully traverse.

MPEP §706.02(j) states that in order to establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all the claim limitations." Applicants respectfully submit that the present rejection has not met this burden.

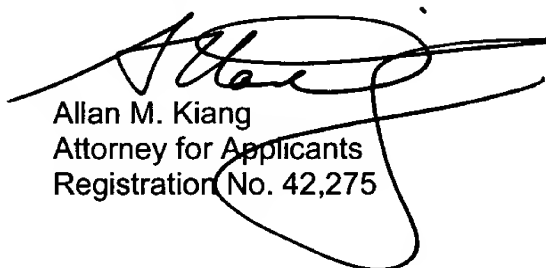
The present office action stated that the particles of Howe may have DNA bound to them (citing col. 4, lines 26-50 and col. 6, line 52). However, Howe does not provide such a teaching. Howe teaches the use of "beads which are **coated** with a reagent to specifically bind with the polymer to be recovered." Column 4, lines 27-28 (emphasis added). In contrast, present claim 16 recites "A method for manipulating magnetizable particles having nucleic acid molecules bound thereto ..." The remainder of the rejected claims (claims 17-20 and 22-28) depend from claim 16. Howe neither teaches nor suggests the binding of nucleic acid molecules directly to the particles. Neither Benner, Tepic nor Beinhaus cures this deficiency. Accordingly, Applicants respectfully submit that a *prima*

facie case of obviousness has not been established. Applicants respectfully request withdrawal of the rejection under 35 USC §103(a).

Conclusion

The claims of the present application are believed to be in condition for allowance and early notice thereof is respectfully requested.

Respectfully submitted,



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